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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,491	09/30/2003	Jeyhan Karaoguz	14822US02	6014

23446 7590 02/21/2008
MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER	
RYAN, PATRICK A	

ART UNIT	PAPER NUMBER
2623	

MAIL DATE	DELIVERY MODE
02/21/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/675,491	KARAOGUZ ET AL.	
	Examiner	Art Unit	
	PATRICK A. RYAN	4126	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This is the First Office Action based on application 10/10675491 filed September 30, 2003. As originally filed, Claims 1-26 are presented for examination.

Specification

1. The disclosure is objected to because of the following informalities: in Paragraph [2] of the specification, the United States Application Serial Numbers for the following documents have been omitted:

a. Attorney Docket No. 14185US0201001P-BP-2800 filed 9/8/2003.

i. The Serial No. assigned to this document is: 10/657390

b. Attorney Docket No. 14274US0201002P-BP-2801 filed 9/8/2003.

i. The Serial No. assigned to this document is: 10/660267

Appropriate correction is required.

Claim Objections

2. Claim 8 is objected to because of the following informalities: the limitation "verifying that said confirmation has been stored" of Claim 8 is not recited in Claim 6 (from which Claim 8 depends). For the purpose of this Office Action, the Examiner interprets the above inconsistency to be a typo and presumes that the Applicant has intended to make Claim 8 dependent form Claim 7, which includes the limitation "comprising storing said confirmation." Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 4, 6, 7, 8, 10, 12, and 13 rejected under 35 U.S.C. 102(e) as being anticipated by Kim (US Patent Application Publication 2003/0214955 A1).

5. In regards to Claims 1, Kim teaches a method for establishing a communication pathway for subsequent media exchanges (Fig. 4 were a “tunnel” is used to create a virtual private network (VPN) between home network 100 and home network 190, as described Paragraphs [0059-0064]) between a television display in a first home and storage that contains media in a second home (The Examiner interprets Kim’s use of "network device” to read on a television, a storage device, or any device with the capability of interfacing with an IP network.), the method comprising: securely receiving address correlation information associated with the television display in the first home (“home gateway 110 can obtain the public IP address of the target home gateway 180 from DNS 150,” as described in Paragraphs [0059-0060], with further reference to steps S400-S430 of Fig. 4); securely receiving address correlation information associated with the storage in the second home (“home gateway 110 can obtain the public IP address

of the target home gateway 180 from DNS 150," as described in Paragraphs [0059-0060], with further reference to steps S400-S430 of Fig. 4); requesting affirmative confirmation using the received address correlation information associated with at least one of the television display and the storage ("notification of the establishment of a tunnel up to the second home gateway 180," as disclosed in Paragraph [0061], with further reference to steps S440-S460 of Fig. 4) and storing the affirmative confirmation ("User information necessary for user authentications is stored in memory part 121" shown in Fig. 2, as disclosed in Paragraph [0053] Lines 5-7).

6. In regards to Claim 2, Kim teaches the method according to Claim 1, further comprising associated with the subsequent media exchanges, verifying that the affirmative confirmation has been stored (Kim's method will inherently verify that the public IP address is stored at home gateway because if the public IP address is not contained in storage the connection between each network will be lost. Therefore, the user is aware that the affirmative confirmation is stored so long as the connection is in operation.)

7. In regards to Claim 4, Kim teaches the method according to Claim 1, wherein at least one of the address correlation information associated with the television display in the first home and the address correlation information associated with the storage in the second home is at least one of a digital certificate, a one-time digital certificate, a one-time code, a device identification, and a key (a device on the first home network is assigned a private IP addresses from second home network once the connection

request has been approved, as disclosed in Paragraph [0063], with further reference to Fig. 4 S480-S490).

8. In regards to Claim 6, Kim teaches a method for establishing a communication pathway for subsequent media exchange (Fig. 4 were a “tunnel” is used to create a virtual private network (VPN) between home network 100 and home network 190, as described Paragraphs [0059-0064]) between a first media component in a first home and a second media component in a second home (The Examiner interprets Kim’s use of "network device” to read on a television, a storage device, or any device with the capability of interfacing with an IP network.), the method comprising: receiving at least one of address correlation information associated with the first media component in the first home and a routing address associated with the first media component in the first home (“home gateway 110 can obtain the public IP address of the target home gateway 180 from DNS 150,” as described in Paragraphs [0059-0060], with further reference to steps S400-S430 of Fig. 4); receiving address correlation information associated with the second media component in the second home (“home gateway 110 can obtain the public IP address of the target home gateway 180 from DNS 150,” as described in Paragraphs [0059-0060], with further reference to steps S400-S430 of Fig. 4); and requesting confirmation using the address correlation information associated with the second media component ("notification of the establishment of a tunnel up to the second home gateway 180,” as disclosed in Paragraph [0061], with further reference to steps S440-S460 of Fig. 4).

9. In regards to Claim 7, Kim teaches the method according to Claim 6, further comprising storing the confirmation ("User information necessary for user authentications is stored in memory part 121" shown in Fig. 2, as disclosed in Paragraph [0053] Lines 5-7).

10. In regards to Claim 8, Kim teaches the method according to Claim 6, further comprising associated with the subsequent media exchange, verifying that the confirmation has been stored (Kim's method will inherently verify that the public IP address is stored at home gateway because if the public IP address is not contained in storage the connection between each network will be lost. Therefore, the user is aware that the affirmative confirmation is stored so long as the connection is in operation).

11. In regards to Claim 10, Kim teaches the method according to Claim 6, wherein at least one of the address correlation information in the first home and the address correlation information in the second home is at least one of a digital certificate, a one-time digital certificate, a one-time code, a device identification and a key (a device on the first home network is assigned a private IP addresses from second home network once the connection request has been approved, as disclosed in Paragraph [0063], with further reference to Fig. 4 steps S480-S490).

12. In regards to Claim 12, Kim teaches a system that supports media exchange between a first home and a second home (Fig. 1 showing a network with multiple home networks, as described in Paragraphs [0036-0042]), the system comprising: a television display in the first home, the television display having an associated first routing

address; storage that contains media in a second home, the storage having an associated second routing address (The Examiner interprets Kim's use of "network device" to read on a television, a storage device, or any device with the capability of interfacing with an IP network.); and a server component that establishes a secure communication pathway through which media contained in the second home is delivered to the television display in the first home ("home gateways 110 and 180 each connect by way of a Public IP address, which is designated by a DNS server 150 [Domain Name Server], for connection with each respective home network 100 and 190." as disclosed in Paragraph [0060]).

13. In regards to Claim 13, Kim teaches the system according to Claim 12, wherein the server comprises a memory that stores at least one of the first routing address and the second routing address (The Public IP address of each home gateway is registered in DNS server 150 together with a unique domain name, as disclosed in Paragraph [0041] Lines 11-15. In order to retain the domain names for any period of time the DNS server must inherently include a memory element.)

14. Claims 16, 17, and 20-26 rejected under 35 U.S.C. 102(e) as being anticipated by Smith (US Patent Application Publication 2004/0133914 A1).

15. In regards to Claim 16, Smith teaches a system for communicating information (peer-to-peer operating model 420 of Fig. 11, as described in Paragraph [0062]), the system comprising: at least one processor (key server 56 in digital media content station 52, as described in Paragraph [0050]) that issues access information from a first

device to at least a second device; the at least one processor transfers at least a portion of the access information to a third device (Key server 56 [station 52 is First Device] generates a private/public key pair for each user, the public key is then sent to each user's media player 12 [user A is the Second Device and user B is the Third Device], as disclosed in Paragraph [0050]); and the at least one processor authenticates the access information by the first device when the third device attempts to transfer at least one of media, data, and service to the at least the second device (With reference to Fig. 12 and Paragraphs [0065-0067], when user B requests media from user A (step 430), user B must also request user A's public key from server 52 (step 440). The server then delivers user A's public key, encrypted with user B's public key, to user B (step 448). User B is therefore only authenticated if user B has a valid and correct public key).

16. In regards to Claim 17, Smith teaches the system according to Claim 16, wherein the at least one processor communicates the access information from the at least the second device to the third device (in step 448 of Fig. 4 server 52 delivers A's public key encrypted with B's public key to user B, as described in Paragraph [0066]).

17. In regards to Claim 20, Smith teaches the system according to Claim 16, wherein the first device is a media exchange server (digital media content station 52, as described in Paragraphs [0041-0042]).

18. In regards to Claim 21, Smith teaches the system according to Claim 16, wherein the at least the second device and the third device is at least one of a media processing system, a personal computer executing media exchange software, and a media

peripheral (digital media stations 26'-26''' of Fig. 11 and further detailed in Fig. 1 as media player 12, as described in Paragraph [0062]).

19. In regards to Claim 22, Smith teaches the system according to Claim 16, wherein the at least one processor permits the third device to communicate with the at least the second device, if the access information is authenticated by the first device ("Digital media player 12 then requests and receives a default object executable only by digital media player 12 from secured digital media content station 52, and verifies the received default object using digital signature using the user's private key to decrypt the encrypted digital signature." As described in Paragraph [0051]. Also see blocks 240 and 242 of Fig. 6).

20. In regards to Claim 23, Smith teaches the system according to Claim 16, wherein the at least one processor at least one of denies and restrict the transfer of the at least one of media, data, and, service between the at least the second device, if the access information is not authenticated by the first device (referring to the citation of Claim 22, if the user does not have a private key or and invalid private key, the user is unable to decrypt "default object executable only by digital media player 12" and therefore is inherently not authenticated by digital media content system 52).

21. In regards to Claim 24, Smith teaches the system according to Claim 16, wherein the access information is at least one of a digital certificate, a one-time digital certificate, a one-time code, a device identification, and a key (key server 56 "generates a user-specific and unique private and public key pair" as disclosed in Paragraph [0050]).

22. In regards to Claim 25, Smith teaches the system according to Claim 16, wherein the at least one processor limits a period for which the access information is valid (digital media server 52 executes anti-hack process 550 of Fig. 13, as described in Paragraph [0068] "in which the current streaming session with tuner is checked to determine whether [the media session] has expired).

23. In regards to Claim 26, Smith teaches the system according to Claim 16, wherein the at least one processor is at least one of a computer processor, a media peripheral processor, a media exchange system processor, a media exchange server processor and a media processing system processor (any one of main server 54, key server 56, content server 60, and checksum server 62 of digital media content station 52 as disclosed in Paragraph [0042]; each of which must inherently comprise a processor).

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

25. Claims 3, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (US Patent Application Publication 2003/0214955 A1) in view of Kenner et al. (US Patent 5,956,716) hereinafter "Kenner."

26. In regards to Claim 3, Kim teaches the method according to Claim 2, but does not teach receiving at least one of the address correlation information associated with the television display in the first home and the address correlation information associated with the storage in the second home via at least one of an in-band channel and an out-of-band channel.

In a similar field of invention, Kenner teach a method of video clip storage and retrieval wherein video clips are stored locally or at a remote location. In addition, Kenner teach the creation of a data sequence interface (DSI), which is created whenever a user request media that is not stored locally to the user's system. Kenner discloses that "this allows the system to use one communication network for querying and another, preferably higher bandwidth, communication network for data downloads (as disclosed in Col. 12 Lines 4-32).

It would have been obvious to one of ordinary skill in the art the time of the invention to combine the method of establishing a communication pathway as taught by Kim, with the method of using a DSI as taught by Kenner in order to reduce bandwidth consumption by transmitting user request or system information in a separate, out-of-band, channel.

27. In regards to Claim 9, Kim teaches method according to Claim 6, but does not teach receiving at least one of the address correlation information in the first home, the address correlation information in the second home, and the routing address via at least one of an in-band channel and an out-of-band channel.

In a similar field of invention, Kenner teach a method of video clip storage and retrieval wherein video clips are stored locally or at a remote location. In addition, Kenner teach the creation of a data sequence interface (DSI), which is created whenever a user request media that is not stored locally to the user's system. Kenner discloses that "this allows the system to use one communication network for querying and another, preferably higher bandwidth, communication network for data downloads (as disclosed in Col. 12 Lines 4-32).

It would have been obvious to one of ordinary skill in the art the time of the invention to combine the method of establishing a communication pathway as taught by Kim, with the method of using a DSI as taught by Kenner in order to reduce bandwidth consumption by transmitting user request or system information in a separate, out-of-band, channel.

28. In regards to Claim 14, Kim teaches the system according to Claim 12, but does not teach wherein the at least one of the first routing address and the second routing address is communicated via at least one of an in-band channel and an out-of-band channel.

In a similar field of invention, Kenner teach a method of video clip storage and retrieval wherein video clips are stored locally or at a remote location. In addition, Kenner teach the creation of a data sequence interface (DSI), which is created whenever a user request media that is not stored locally to the user's system. Kenner discloses that "this allows the system to use one communication network for querying

and another, preferably higher bandwidth, communication network for data downloads (as disclosed in Col. 12 Lines 4-32).

It would have been obvious to one of ordinary skill in the art the time of the invention to combine the method of establishing a communication pathway as taught by Kim, with the method of using a DSI as taught by Kenner in order to reduce bandwidth consumption by transmitting user request or system information in a separate, out-of-band, channel.

29. Claims 5, 11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (US Patent Application Publication 2003/0214955 A1) in view of Smith et al. (US Patent Application Publication 2004/0133914 A1) hereinafter "Smith."

30. In regards to Claim 5, Kim teaches the method according to Claim 1, but does not teach limiting a period for which at least one of the address correlation information associated with the television display in the first home and the address correlation information associated with the storage in the second home is valid.

In a similar field of invention, Smith teach a method of operating a peer-to-peer network that enables multiple users to share digital media files. In addition, Smith's method includes an anti-hack process 550 that periodically checks to determine whether a streaming media session has expired (as disclosed in Paragraph [0068], with further reference to Fig. 13 block 551).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combined the method of establishing a communication pathway as taught

by Kim with the time expiration method of Smith because, as disclosed by Smith, an expiration time on a streaming media session would prevent an individual, such as a hacker, from using an expired access key (as disclosed in Smith, Paragraph [0068]).

31. In regards to Claim 11, Kim teaches the method according to Claim 6, but does not teach limiting a period for which at least one of the address correlation information in the first home and the address correlation information in the second home is valid.

In a similar field of invention, Smith teach a method of operating a peer-to-peer network that enables multiple users to share digital media files. In addition, Smith's method includes an anti-hack process 550 that periodically checks to determine whether a streaming media session has expired (as disclosed in Paragraph [0068], with further reference to Fig. 13 block 551).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combined the method of establishing a communication pathway as taught by Kim with the time expiration method of Smith because, as disclosed by Smith, an expiration time on a streaming media session would prevent an individual, such as a hacker who may attempt to abuse the system, from using an expired access key (as disclosed in Smith, Paragraph [0068]).

32. In regards to Claim 15, Kim teaches the system according to Claim 12, but does not teach wherein the server authenticates an initial access of at least one of the television display having an associated first routing address and the storage having an associated second routing address.

In a similar field of invention, Smith teach a system of operating a peer-to-peer network that enables multiple users to share digital media files. Each user of Smith's system is designated a session key that consists of a unique private/public key pair. The session keys are generated by key server 56 of Fig. 2. In addition, Smith discloses "a checksum server (not shown) associated with station 52 may generate or supply... [a] checksum native application" from Smith Paragraph [0052]. Smith's checksum operation distributes an application that is executed by the user's multimedia player and then returned to secure digital media content station 52a. At station 52a, the result of the application is verified against a know result (see blocks 272-274) and if the result matches the expected result, the user is then authorized (as disclosed in Paragraph [0052]).

In would have been obvious to on of ordinary skill in the art at time of the invention to combine the system of establishing a communication pathway as taught by Kim with the checksum server of Smith because requiring the authentication of a user before providing access to media content would prevent an individual, such as a hacker, from using an expired access key (as disclosed in Smith, Paragraph [0068]).

33. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US Patent Application Publication 2004/0133914 A1) hereinafter "Smith" in view of Kenner et al. (US Patent 5,956,716) hereinafter "Kenner."

34. In regards to Claim 18, Smith teaches the system according to Claim 16, but does not teach wherein the at least one processor communicates the access

information from the at least the second device to the third device via at least one of an in-band channel and an out-of-band channel.

In a similar field of invention, Kenner teach a system of video clip storage and retrieval wherein video clips are stored locally or at a remote location. In addition, Kenner teach the creation of a data sequence interface (DSI), which is created whenever a user request media that is not stored locally to the user's system. Kenner discloses that "this allows the system to use one communication network for querying and another, preferably higher bandwidth, communication network for data downloads (as disclosed in Col. 12 Lines 4-32).

It would have been obvious to one of ordinary skill in the art the time of the invention to combine the method of establishing a communication pathway as taught by Kim, with the method of using a DSI as taught by Kenner in order to reduce bandwidth consumption by transmitting user request or system information in a separate, out-of-band, channel.

35. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US Patent Application Publication 2004/0133914 A1) hereinafter "Smith" in view of Garneau et al. (US Patent 5,675,647) hereinafter "Garneau."

36. In regards to Claim 19, the combination of Smith and Kenner teach the system according to claim 17, but do not teach the system further comprising a telephone device that is utilized to inform a user of the third device of the access information.

In a similar field of invention, Garneau teach a system of distributing signals to valid subscribers comprised of storing subscriber terminal identification codes at a central station (system shown in Fig. 3). In addition, the Garneau system includes telephone 25 of Fig. 1 that provides a subscriber with a password. The password can then be used to gain access to desired programming (as disclosed in Col. 7 Lines 39-67 and Col. 8 Lines 1-25).

It would have been obvious to one of ordinary skill in the art at the time if the invention to combined the system of Smith and Kenner with the system of Garneau because a telephone is a well known and commonly used communications device. In addition, since virtually every household contains a telephone system, no new infrastructure would be required to implement the present invention, which would therefore reduce the overall cost.

Conclusion

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made. Applicant must show how the amendments avoid such references and objections. See 37 CFR 1.111(c).

38. US Patent 6,865,555 B2, Novak, teaches a system and method of verifying a user on a network using a license key from verification entity. The license key may be

used to decrypt digital media content. In addition, the license key may be transferred to a second user for media sharing.

39. US Patent 7,302,487 B2, Ylonen et al., teach a method for setting up communication parameters in a virtual private network. A hardware token containing a private key and a certificate or a public key corresponding to the private key, are used to establishes a secure connection between users on the network.

40. US Patent Application Publication 2002/0143959 A1, El-Baze et al., teach a method and apparatus for a peer-to-peer multimedia streaming link to be setup in real-time between two or more remote computing devices. A switch server is used to provide a notification of a request for transfer to a destination device. The connection between devices in the system is established using a port-to-port protocol.

41. US Patent Application Publication 2002/0154892 A1, Hoshen et al., teach a method of distributing content on demand over a cable network in which multiple subscribers are connected to a Central Unit.

42. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick A. Ryan whose telephone number is (571) 270-5086. The examiner can normally be reached on Mon to Thur, 8:00am - 5:00pm EST.

43. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Chow can be reached on (571) 272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick A Ryan/
Examiner, Art Unit 4126
Wednesday, February 20, 2008

/Dennis-Doon Chow/

Supervisory Patent Examiner, Art Unit 4126